

REMARKS**Serial No. 10/612,143**

Favorable consideration of the present application, as amended, is respectfully solicited.

Applicant affirms the provisional election with traverse to prosecute the invention of Group I, claims 1-22 and 31.

Applicant respectfully requests that the Examiner withdraw the double patenting rejection of claims 1-31 based on 35 USC 101 because these claims do not claim the same invention as claims 1-59 of prior U.S. patent 6,619,002. Claim 1 and dependent claims 2-22 all include the limitation fastener-receiving bore means in at least certain of said outer edge portions of the plate. There is absolutely no claim in patent 6,619,002 of the foregoing claimed subject matter. In fact, there is absolutely no disclosure in patent 6,619,002 of the foregoing claimed subject matter. Claim 31 is different than any one of the fifty-nine claims in patent 6,619,002. It is submitted that a claim of this scope, even though it reads on the disclosure of parent patent 6,619,002, does not constitute 35 USC 101 double patenting.

It is to be noted that the Examiner rejected claims 1-31 on 35 USC 101 notwithstanding that claims 23-30 were withdrawn based on the requirement for restriction. Accordingly, it is believed that a response should be made thereto, and it is submitted that these claims are also not subject to a 35 USC 101 rejection. In this respect, claim 23 and dependent claims 24-27 dependent thereon include the

limitation "fastener-receiving bores in said outer edge portions which overlie said joists." Patent 6,619,002 does neither claim this subject matter, nor even disclose it. Claim 28 and dependent claims 29 and 30 include the limitation "fastener-receiving bores in said outer edge portions, and fasteners extending through said fastener-receiving bores into said joists." Patent 6,619,002 neither claims nor discloses the foregoing limitations. Accordingly, it is submitted that the 35 USC 101 rejection of these claims should also be withdrawn.

It is respectfully requested that withdrawn claims 23-30 be rejoined with claims 1-22 and 31. The criterion for restriction between a combination and subcombination is governed by MPEP 806.05(c), as stated by the Examiner. MPEP 806.05(c) states:

"In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated.

"To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search. See MPEP §808.02.

"The inventions are distinct if it can be shown that a combination as claimed:

"(A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and

"(B) the subcombination can be shown to have utility either by itself or in other and different relations.

"When these factors cannot be shown, such inventions are not distinct."

In the present series of claims, claim 1, which was elected, essentially appears substantially in its entirety in independent claims 23 and 28 which were withdrawn. Therefore, criterion (A) is obviously not met. In addition, criterion (B) must also be met, namely, that "the subcombination can be shown to have utility either by itself or in other and different relations." It is not seen where this could be the case. The tiles of claims 1-22 must be used with joists such as recited in claims 23 and 28. This is their purpose. Therefore, criterion B is also not met.

The Examiner specifically gave reasons as follows for substantiating the requirement for restriction:

"In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination can be used with a tile having additional features besides those claimed in group I. The subcombination has separate utility such as the tile can be used with a flooring system containing additional elements besides what is just claimed in Group II. The tiles could be mounted on alternative structure such as a pedestal."

It is submitted that the reasons presented by the Examiner are not valid. The Examiner stated that the combination as claimed does not require the particulars of the subcombination as claimed because the combination can be used with a tile having additional features besides those claimed in Group I. The issue is not whether the combination can be used with a tile having additional features besides those claimed in Group I; the issue is whether the subcombination as claimed is required by the combination as claimed, as stated in Section A of MPEP

806.05(c). As expressed above, applicant's combination as claimed requires the particulars of the subcombination as claimed. Whether the tile can have additional features is immaterial.

As an additional reason the Examiner stated "The subcombination has separate utility such as the tile can be used with a flooring system containing additional elements besides what is just claimed in Group II." Here again it is submitted that the foregoing is not a valid criterion; the issue is as stated in Section B of MPEP 806.05(c), namely, whether the subcombination can be shown to have separate utility either by itself or in other and different relations. To meet this requirement, the Examiner stated "The subcombination has separate utility such as the tile can be used with a flooring system containing additional elements besides what is just claimed in Group II." (Emphasis added) It is submitted that this is not a valid reason. The fact that a flooring system which may contain additional elements beside what is just claimed in Group II does not negate the existence of the claimed elements with which the subcombination is used. The Examiner also stated "The tiles could be mounted on alternative structure such as a pedestal." It is submitted that this also is not a valid reason because the claimed tiles cannot be mounted on alternative structure such as a pedestal; their claimed structure is for mounting on joists.

The Examiner in the restriction requirement stated that the claims of Group I are classified in class 52,

subclass 126.6 and that the claims of Group II are classified in class 52, subclass 741.1. Assuming solely for the sake of argument that there are different classifications, it is submitted that the matter of different classifications in the present case does not enter into whether restriction is proper. In this respect, MPEP 806.05(c) includes the following paragraph:

"To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search. See MPEP §808.02.

The reasons for insisting on restriction such as separate classification are **in addition** to requiring the two-way distinctness set forth in paragraphs (A) and (B) of MPEP 806.05(c). Thus, if the two-way distinctness has not been established, which it is submitted has not been established here, the reasons such as separate classification are not reached.

It is to be noted from the **Office Action Summary** that claims 1-22 and 31 are rejected. However, in the DETAILED ACTION claims 1-6, 16-17, 19 and 31 are the only ones which were rejected. The undersigned attorney placed a phone call to Examiner Chapman to inquire whether there should be an additional Office Action relative to claims 7-15, 18 and 20-22. The Examiner replied that the last-mentioned claims should be treated in the same manner as claims 1-6, 16-17, 19 and 31. Accordingly, this procedure will be followed.

The rejection of claims 1-6, 16-17, 19 and 31 under 35 USC 103 as being unpatentable over Zinniel in view of Scissom is respectfully traversed. Insofar as pertinent here, the Examiner stated that Zinniel includes "the tile assembly; a plurality of channel members having legs and a web with the ledgs [sic] being for positioning alongside the inner flanges; see figures 5 and 7." This is not accurate. Zinniel does not show the plurality of channel members. Zinniel shows only angles 14 which are termed "panel support stringers" in column 3, line 8, by the patentee.

As noted above, the Examiner stated that Zinniel lacks the fastener receiving bores as shown by Scissom, element 187. However, element 187 of Scissom is not a bore. It is a surface for engaging the pedestal head 130 (column 7, lines 27, 28). The Examiner also stated that Scissom also discloses the bores "proximate in the four corners of the plate/tile and the outer edge portions between the inner and outer flanges: the outer edge element 186, inner flange 188, and theouter [sic] flange 170." This is not accurate. The patent at column 6, line 67, calls element 170 a side wall and it appears to be the edge of the top plate. It is not a flange as stated by the Examiner.

The Examiner also stated "Scissom shows two pairs of outer edge portions with bores 75/775." There are no such numbers in Scissom. The numbers 75 and 775 are in the Peart patent. The number 75 in the Peart patent is a lower chamber as set forth in column 5, line 27. The number 775 appears in FIG. 1 of the Peart patent and is located in

element 790 which Peart refers to as an indexing element in column 16, line 30. However, the numeral 775 does not appear in the text of column 16. Numeral 775 is defined as a spacing member in column 7, line 52; there is nothing in the Peart specification which describes the structure to which the lead line 775 in FIG. 1 is directed.

The Examiner also stated "Scissom also discloses the bores located in blocks see figures 2 and 5." The Examiner did not designate such bores with a number and FIGS. 2 and 5 do not appear to have any bores therein.

The Examiner also stated "Scissom shows the ribs 202/208 molded into the inner/outer flanges lower surface; see figure 5." In Scissom numeral 202 represents a rib (column 6, line 61). Numeral 208 (FIG. 5, left side) does not appear to be in the specification, but from FIG. 5 it appears to be the same item of structure as item 202 which is described as an interior rib at column 6, line 61. In any event, the relevance of the Examiner's statement is not understood.

The Examiner also stated "Zinniel also lacks the outer flanges extending outwardly from the inner flanges as shown by Peart et al (6684582), element 75/775." As noted above, the Peart numeral 775 appears in FIG. 1 but is described in the Peart specification as a spacing member at column 7, line 50. Element 75 in Peart is a lower chamber as set forth in column 5, line 27.

In short, based on the foregoing, it is extremely difficult to respond to the rejection. In any event it is

submitted that there is no motivation for combining the Zinniel, Scissom and Peart patents because it appears that the Examiner attempted to take isolated elements of structure from three patents and combine such structure to meet the claims when there was no suggestion whatsoever in the patents themselves that elements thereof could be combined to meet applicant's claimed structure.

It is submitted the Examiner has not properly interpreted the Zinniel patent. In this respect, the Examiner specifically stated that "Zinniel lacks the fastener receiving bores ...". However, a review of the Zinniel patent shows fastener receiving bores 86 which receive fasteners 84. See FIG. 6 and column 4, line 66. Accordingly, claim 1 and dependent claims 2-22 have been amended to define patentably over Zinniel. In this respect, claim 1 now includes the clause "fastener-receiving bore means aligned between said inner and outer flanges in at least certain of said outer edge portions for receiving fasteners which are received in joists to secure said tile to said joists." The foregoing is a "means plus function" clause which is directed to subject matter shown in the specification and equivalents thereof. Zinniel does not possess the claimed "means plus function" structure of the foregoing quoted clause. In this respect, the Zinniel fasteners 84 are not received in joists. They coact with stringer clamps 82 to secure the plates to the angles 14. Additionally, the fastener-receiving bores 86 of Zinniel are not "located between said inner and outer flanges." As can

be seen from FIG. 6 of Zinniel, the bores 86 extend on the opposite side of inner flange 62 from outer flange 62a and thus they completely miss angle 14.

It is submitted that claims 2-22 which are directly or indirectly dependent on claim 1 are patentable for the same reasons as claim 1.

Claim 2 adds to claim 1 that the plate includes corners and that the fastener-receiving bore means are located proximate the corners of the plate.

Claim 3 adds to claim 1 that the outer edge portions are between the inner and outer flanges.

Claim 4 adds to claim 1 that plate has two pairs of opposite edge portions and that the fastener-receiving bore means are located in at least one pair of the outer edge portions.

Claim 5 adds to claim 4 that the fastener-receiving bore means are also located in the other of the pairs of fastener-receiving bores.

Claim 6 adds to claim 1 that the fastener-receiving bore means are located in blocks. The Zinniel patent does not have this structure.

Claim 7 adds to claim 6 that the plate includes corners and that the blocks are located proximate the corners of the plate.

Claim 8 adds to claim 6 that the outer edge portions are between the inner and outer flanges and that the blocks are located between the inner and outer flanges.

Claim 9 adds to claim 6 that the plate has two pairs of opposite outer edge portions and that the fastener-receiving bore means are located in at least one pair of the opposite outer edge portions.

Claim 10 adds to claim 9 that the fastener-receiving bore means are also located in the other of the pairs of opposite outer edge portions.

Claim 11 adds to claim 1 enlarged bores overlying the fastener-receiving bore means and plugs for fitting into said enlarged bores. This structure is shown in FIG. 25, and this structure is not shown in Zinniel.

Claim 12 is dependent on claim 11 and locates the fastener-receiving bore means and the enlarged bores at the corners of the plate.

Claim 13 is dependent on claim 11 and it locates the outer edge portions of the plate between the inner and outer flanges.

Claim 14 adds to claim 11 that the plate has two pairs of opposite outer edge portions and that the fastener-receiving bore means are located in at least one pair of the opposite outer edge portions.

Claim 15 adds to claim 14 that the fastener-receiving bore means are also located in the other of the pairs of opposite outer edge portions.

Claim 16 adds to claim 1 that the first ribs which are molded integrally with the inner flanges and the lower surface and second ribs which are molded integrally with the inner and outer flanges on the lower surface.

Claim 17 adds to claim 16 that the first ribs are also molded integrally with each other.

Claim 18 adds to claim 16 that the inner flanges have lower edges and slots extending inwardly into said inner flanges from said lower edges. No such structure is shown in Zinniel.

Claim 19 has been amended to recite a plurality of channel means for mounting on said joists with each of the channel means having legs and a web and said legs being for positioning alongside the inner flanges between the inner flanges and the joists and the outer flanges for resting on the webs located between the outer flanges and the joists. No such structure is shown in Zinniel.

Claim 20 adds to claim 19 that the inner flanges have lower edges with slots extending inwardly into the inner flanges from the lower edges and pins extending outwardly from the legs and received in the slots. No such structure is shown in Zinniel.

Claim 21 adds to claim 20 the first ribs which are molded integrally with the inner flanges and the lower surface and that second ribs are molded integrally within the inner and outer flanges and the lower surface.

Claim 22 adds to claim 21 that the first ribs are also molded integrally with each other.

It is submitted that amended claim 31 defines patentably over Zinniel. In this respect it includes "inner flange means extending downwardly from said plate for extending along a joist in close parallel relationship

thereto and in effective engagement therewith." Zinniel does not possess this structure. First of all, angles 14 of Zinniel are not joists. Additionally, flanges 62 which are parallel to flanges 62a are not in effective engagement with the sides of angles 14, even if angles 14 should be considered equivalent to a joist.

As noted above, the rejection specifically treated only claims 1-6, 16-17, 19 and 31. The Examiner indicated, in a telephone inquiry, that the remainder of the claims, namely, claims 7-15, 18 and 20-22, are to be considered rejected in the same manner as claims 1-6, 16-17, 19 and 31. Accordingly, it is submitted that claims 7-15, 18 and 20-22 are not validly subject to a 35 USC 103 rejection as being unpatentable over Zinniel in view of Scissom for the same reasons given above relative to claims 1-6, 16-17, 19 and 31.

Claims 32-36 have been added by the present amendment. Claim 32 is dependent on claim 1 and reflects a tile assembly which includes a plurality of tiles as set forth in claim 1, a plurality of joists on which the outer flanges of the plurality of tiles rests and fasteners extending through the bore means and received in the joists. No such structure is shown in any of the cited references of record, as discussed in greater detail above.

Claim 33 adds to claim 32 the enlarged bores overlying the bore means and plugs fitting in the enlarged bores.

Claim 34 adds to claim 32 that the tiles have corners and that the fastener-receiving bore means are located at the corners.

Claim 35 adds to claim 34 the blocks in the corners which contain bore means.

Claim 36 adds to claim 35 the enlarged bores overlying the bore means and plugs fitting into the enlarged bores. It is submitted that none of the references of record teach the subject matter of claims 33-36.

A check in the amount of \$45 is transmitted herewith in payment for the five dependent claims submitted with this amendment. Any deficiency may be charged to Account No. 07-0450 of the undersigned.

In view of the foregoing remarks the following actions are respectfully requested (1) withdrawal of the requirement for restriction (2) withdrawal of the 35 USC 101 double patenting rejection (3) withdrawal of the rejection of claims 1-6, 16-17, 19 and 31 as being unpatentable over Zinniel in view of Scissom, and (4) favorable consideration and allowance of claims 1-22 and 31-36.

Respectfully submitted,

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